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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,957	04/13/1999	JOHN S. HENDRICKS	5267	9303

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EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/289,957

Applicant(s)

HENDRICKS ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 and 217-220 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 12, 13 and 217 is/are rejected.
- 7) ☒ Claim(s) 5, 9-11, 14-58 and 218-220 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-58 and 217-220 are drawn to secure transactions including authentication, classified in class 705 subclass 67.
  - II. Claims 59-92 are drawn to electronic book viewing, classified in class 705 subclass 1.
  - III. Claims 93-118 are drawn to usage protection of data files, classified in class 705 subclass 51.
  - IV. Claims 119-216, drawn to secure transactions, classified in class 705 subclass 64.

Inventions I, II III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed such as a an Electroniv book view in the instance of invention II, broadcasting an authorization signal in invention III and a delivery system in invention IV. The subcombination has separate utility such as a viewing an electronic book or receiving an authoring signal or a delivery system.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that is would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via the paper filed on July 20, 2004 the applicant has elected the examination of invention I directed towards claims 1-58 and 217-220. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29 and 32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-58 and 217-220

***Claim Rejections - 35 USC § 112***

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 recites the limitation "digital television". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6-8,13 and 217 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman et al. (US Patent 5,893,132) in view of Schneck et al. (US Patent 5,933,498).

As per claim 1,

Huffman et al. ('132) discloses an apparatus that provides electronic books to a subscriber, comprising;

a receiver module that receives a data signal and a local authorization code, wherein the data signal comprises an encrypted electronic book selection and wherein the local authorization code allows the data signal to be decrypted for viewing;(Figure 36)

Huffman et al. ('132) does not explicitly disclose a processor that communicates with an electronic book ordering site, the processor supplying an electronic book selection and a processor identification; a transmitter, coupled to the processor, that sends the electronic book selection and the processor identification to the ordering site; a memory coupled to the receiver module, the memory storing the received authorization code until needed for decrypting the data signal. Schneck et al. ('498) discloses a processor that communicates with an electronic book ordering site,(Figure 1) the processor supplying an electronic book selection and a processor identification;(Figure 12) a transmitter, coupled to the processor, that sends the electronic book selection and the processor identification to the ordering site; a memory coupled to the receiver module, the memory storing the received authorization code until needed for decrypting the data signal. (Figure 7) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Huffman et al. ('132)'s method with Schneck et al. ('498)'s teaching in order to allow the consumer download authenticated copies of electronic media.

As per claim 2,

Huffman discloses the apparatus of claim 1, further comprising:

a viewer capable of receiving data, wherein the viewer, comprises:

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- a decryptor that decrypts the data signal,(Figure 3)
- a display that displays pages of the electronic book,(Figure 3)
- a book memory that stores the electronic book, (Figure 3)
- a control module that controls viewing of the electronic book.(Figure 3)

As per claim 3,  
Huffman discloses the apparatus of claim 2,  
wherein the receiver module, the processor, the transmitter and the memory are contained in a library unit, the apparatus further comprising an interface between the library unit and the viewer.(Figure 3)

As per claim 4,  
Huffman discloses the apparatus of claim 2,  
wherein the library unit further comprises an external interface to an external receiver, the external receiver receiving the data signal, the external interface transmitting the data signal to the library unit.(Figure 3)

As per claim 6,  
Huffman discloses the apparatus of claim 4,  
wherein the external receiver is a radio receiver (column 7, lines 53-58)

As per claim 7,  
Huffman discloses the apparatus of claim 4,  
wherein the external receiver is a spread spectrum receiver.(column 7, lines 53-58)

As per claim 8,  
Huffman discloses the apparatus of claim 4,  
wherein the external receiver is a modem.(column 7, lines 53-58)

As per claim 13,  
Huffman discloses the apparatus of claim 2,  
wherein the receiver module, the processor, the transmitter, and the memory are incorporated into a personal computer.(Figure 3)

As per claim 217,  
Huffman et al. ('132) discloses a system for delivering electronic books, comprising:

- a plurality of machines, a machine of the plurality of machines, comprising:
  - a microprocessor,(Figure 3)
  - a transceiver coupled to the microprocessor,(Figure 3) and
  - a memory coupled to the microprocessor that stores one or more electronic books related to the machine;(Figure 3)
- an electronic book viewer operably coupled to the interface, wherein on

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a command from the electronic book viewer, the machine transmits an electronic book from the memory to the electronic book viewer.(Figure 3)

Huffman et al. ('132) does not explicitly disclose a network coupled to the plurality of machines; an interface coupled to the network. Schneck et al. ('498) discloses a network coupled to the plurality of machines; an interface coupled to the network (Figure 1) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Huffman et al. ('132)'s method with Schneck et al. ('498)'s teaching in order to allow the consumer download copies of electronic media.

### *Allowable Subject Matter*

Claims 5, 9,10,11,14-58 and 218-220 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

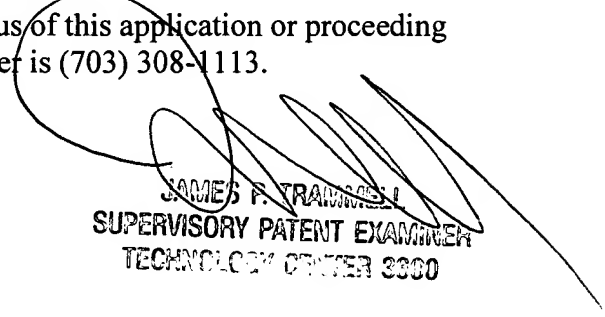
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW  
July 26, 2004

  
JAMES P. TRAMMELL  
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